

B3
22. (Once Amended) The patch bag according to Claim 1, wherein the patch is adhered to an outside surface of [a] the bag.

REMARKS

The Pending Claims, the Amendments to the Claims, and the Objections to the Claims

Applicants note that with the entry of the above amendments, Claims 1-7, 18, 20, and 22-35 are pending (of which only Claims 1, 18, and 20 are independent claims), each of these claims being directed to a patch bag, with Claims 8-17, 19, and 21 having been withdrawn from consideration as directed to a non-elected invention.

The amendment of Claim 18 by the addition of a final clause thereto is supported by Figures 11 and 12, and the accompanying description located at Page 33 line 14 through Page 34 line 3. Figures 11 and 12, together with the accompanying description on Pages 33-34, disclose a patch bag having a patch which covers both the first seamless side edge of the bag and the second seamless side edge of the bag, as well as a backseamed seal which is through the first film (the bag film) but not through the second film (the patch film).

The amendment of Claim 20 by the addition of a final clause thereto is supported by Figures 3, 4A, and 4B, and the accompanying description located at Page 22 line 11 through 19. Figures 3, 4A, and 4B, together with the accompanying description on Page 22, disclose a patch bag having a patch which covers a seamless bottom edge of a side seal bag, with the side seals being through the first film (the bag film) but not through the second film (the patch film).

The 21 July Office Action states that Claims 18 and 22 are objected to for various informalities, i.e., "a length of the bag," (Claim 18) and "a bag" (Claim 22). Applicants have hereinabove amended each of Claims 18 and 22 to correct these informalities, and Applicants appreciate the Examiner's attention to these details. No new matter is present in the amendments to the claims.

The Rejections under 35 USC 112

In the 21 July Office Action, Claims 24, 25, and 28 are rejected under 35 USC 112, first paragraph, as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. More specifically, the Office Action states that

the recitation of "3 to 6 mils" in Claim 24, and "the bag has only one patch adhered thereto" in Claim 25, constitute new matter.

In response, Applicants contend that the application, as filed, provides support for each of Claims 24, 25, and 28. Each of these claims was presented for the first time in the Preliminary Amendment filed 16 April 1999. Applicants direct attention to Page 22 lines 21-22 as support for the recitation of "3 to 6 mils" in Claim 24; and to Figures 2A, 4B, 10, 11, 12, and 13, and accompanying descriptions at Page 22, 23, 33, and 34 of the specification, as well as to Page 2 lines 8-10 of the specification as originally filed, as support for the recitation of "only one patch" in Claims 25. As a result of the disclosure in these various portions of the application as filed, Applicants contend that Claims 24 and 25 contain no new matter.

As to Claim the rejection of Claim 28, Applicants respectfully note that Claim 28 is not dependent upon either of Claims 24 or 25, and that it does not contain either "3 to 6 mils" or "only one patch." Accordingly, there does not appear to be any basis set forth in the Office Action for the rejection of Claim 28 under 35 USC 112, first paragraph. Moreover, the various recitations in Claim 28 are supported by, for example, Figures 11 and 12, and the accompanying description at Page 33 lines 14-23. Applicants respectfully request that the 35 USC 112 first paragraph rejection of Claim 28 be withdrawn.

In summary, Applicants contend that the application, as filed, supports each of the pending claims, and that the various rejections under 35 USC 112, first paragraph, should be withdrawn in view of the arguments set forth above.

The BRADY et al Reference and the COMPTON Reference

As is discussed below, various pending claims have been rejected as anticipated by BRADY et al or obvious over BRADY et al in view of COMPTON. At the outset, Applicants point out that BRADY et al is directed to a "full width patch bag," in which the patch extends across the entire width of the bag, and even beyond in most disclosed embodiments. See the Abstract of BRADY et al. In almost every embodiment disclosed in BRADY et al, each patch covers only one lay-flat side of the bag, i.e., the patch does not cover a bag side or bottom edge and does not extend over both lay-flat sides of the bag. The only exception is the embodiment of Figures 11 and 12 (relied upon in the Office Action). However, this embodiment, consistent

with the "full width patch" objective of BRADY et al, has the patch covering the entire bag width by sealing through both the patch and the bag. Thus, it is clear that BRADY et al teaches full width patch coverage by either (1) adhering patches to only one lay-flat side of the bag, as illustrated in Figures 1, 2, 8, 9, and 10 or (2) sealing through both the patch and the bag, as illustrated in Figures 11 and 12.

In contrast, Applicants claimed invention is directed to a patch bag in which (a) the same patch covers portions of both lay-flat sides of the bag, with (b) the seals being through the bag film, not the patch film. See independent Claims 1 (as amended in the Preliminary Amendment) and independent Claims 18 and 20 (as amended hereinabove), as well as Figures 1, 2A, 2B, 3, 4A, 4B, 10A, 10B, 10C, 10D, 10E, 10F, 10G, 10H, 11, 12, 13A, 13B, 13C, and 13D. Thus, there are clearly two distinct differences between the teachings of BRADY et al and Applicants' claimed invention. The first difference is that BRADY et al teaches confining the patch to a single lay-flat side of the bag, whereas Applicants have the same patch covering both lay-flat sides of the bag. The second difference is that in the only instance in which BRADY et al teaches to have the same patch covering both lay-flat sides of the bag, BRADY et al teaches the need to seal through both the patch and the bag. In contrast, Applicants teach (and claim) sealing only through the bag film, while at the same time requiring that the same patch cover both lay-flat sides of the bag.

COMPTON teaches making bags, pouches, casings, etc by sealing a film to itself. A preferred film disclosed and utilized in COMPTON is the same film used for the patch in both BRADY et al and Applicants' specification. COMPTON focuses on the bursting strength of the bag, not its puncture-resistance. COMPTON makes no mention of patches on bags. One of ordinary skill in the art, using COMPTON to modify BRADY et al, would use the bag film in COMPTON to toughen and strengthen the bag film used in BRADY et al. One of ordinary skill in the art would not discard the objective of BRADY et al to provide the bag with a "full-width patch." As discussed above, Applicants' claimed subject matter is different from, and mutually exclusive of, BRADY et al's full patch width, because BRADY et al either confines each patch to one lay-flat side (which Applicants exclude from their claimed subject matter) or seals through the patch and the bag (which Applicants also exclude from their claimed subject matter). As a result, Applicants contend that their claims, as amended hereinabove and in the

Preliminary Amendment, are patentable over BRADY et al alone, as well as patentable over BRADY et al in view of COMPTON.

The Rejection under 35 USC §102(b)

In the 21 July Office Action, Claims 1-7, 20, 22-25, and 31-35 are rejected as anticipated by WO 96/00699 to Brady et al ("BRADY et al"). The Office Action refers specifically to Figure 12 of BRADY et al, and states that BRADY et al discloses plastic patch bags with patches adhered over the bag, with: a seam in the bag, not in the patch; both bag and patch films being heat-shrinkable and biaxially-oriented; bags having functional layers; various polymers in the bag and patch films; patch width of 20-190% or 101-200% of bag width; thickness of bag; thickness of patch; and, bag with only one patch.

In response, Applicants contend that each of Claims 1-7, 20, 22-25, and 31-35 are patentable over BRADY et al. Applicants note that Claims 1 and 20 are the only independent claims rejected under §102. Claim 1, as amended in the Preliminary Amendment, recites "... wherein the bag comprises a first film and the patch comprises a second film, and the side-seal is through the first film but not through the second film." Figures 11 and 12 of BRADY et al do not disclose a patch bag having a side seal running the length of the bag, in which the side seal is through the bag film but not through the patch film. Rather, side seal 246 in Figures 11 and 12 of BRADY et al is through both the patch film and the bag film. The side-seal in Applicants' claimed patch bag is, for example, seal 28 as illustrated in Applicants' Figure 1. In Applicants' Figure 1 embodiment, the first film is the bag film and the second film is the patch film. Unlike the patch bag of Figures 11 and 12 of BRADY et al, in the embodiment of Applicants' Figure 1, side seal 28 is through the bag film, but not through the patch film. Claim 1 reflects this structure. Thus, Applicants are claiming a patch bag in which the seal is through the bag film, but not through the patch film. Figures 11 and 12 of BRADY et al do not teach or suggest this feature, and as such, Claim 1 (and all claims depending therefrom) are not anticipated by Figure 12 of BRADY et al.

Figures 11 and 12 of BRADY et al disclose a patch bag in which a fully laminated structure is first prepared, with the entire patch bag being made up of the laminated structure, with the seals necessarily being through both of the films, i.e., through both the inside (bag) film and the outside (patch) film. Moreover, BRADY et al teaches to use patches to cover the full

width of the patch bag. See the Abstract of BRADY et al, which refers to a "full width patch bag", i.e., a patch bag in which the patch covers across the entire width of the bag. In stark contrast, Applicants' Claim 1 is necessarily a patch bag having a "less than full width" patch, because the side seal is through the first film (the bag film), but not through the second film (the patch film). This arrangement necessarily leaves a portion of the width of the bag not covered by a patch. Of course, this means that the subject matter of Applicant's Claims 2-7 and 22-25 are also novel over BRADY et al, as they depend from Claim 1.

Applicants independent Claim 20 is directed to a patch bag having both *first and second side seals* and *a seamless bottom edge*, and *a single patch which covers the seamless bottom edge* of the bag. In stark contrast, Figures 11 and 12 of BRADY et al illustrate a patch bag having *only one* side seal (i.e., side seal 246), and has a *seamed* bottom seal (i.e., bottom seal 248). Thus, it is clear that Figures 11 and 12 of BRADY et al do not anticipate independent Claim 20.

Based on all of the above arguments, Applicants respectfully request withdrawal of the rejection of Claims 1-7, 20, 22-25, and 31-35 as anticipated by BRADY et al.

The Rejection under 35 USC §103

In the 21 July Office Action, Claims 18, 20, and 26-35 are rejected under 35 USC 103 as unpatentable over BRADY et al in view of U.S. Patent No. 5,846,620, to Compton ("COMPTON"). BRADY et al is relied on as set forth in the rejection under §102, with the Office Action further stating that BRADY et al does not teach the backseamed seals of Claims 18 and 20. The Office Action goes on to state that COMPTON teaches the use of backseaming in plastic packaging for products which have a heavy risk of puncture. In the Office Action, it is concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to employ the puncture-resistant seals of COMPTON in making the patch bags of BRADY et al, since they are to be used to package bone-in meat products which could puncture the packaging.

In response, Applicants contend that Claims 18, 20, and 26-35 are patentable over BRADY et al in view of COMPTON. Applicants note that of these rejected claims, only Claims 18 and 20 are independent claims. Applicants turn first to independent Claim 18, and

Claims 26-30 which depend from Claim 18. Claim 18, as amended above, recites a patch bag having a bottom seal, a backseamed seal, seamless first side edge, seamless second side edge, a patch covering both seamless side edges, with the backseamed seal being through the first film (i.e., the bag film) but not being through the second film (i.e., the patch film). The embodiment of Figures 11 and 12 of BRADY et al has only one seamless side edge, and has no backseamed seal running the length of the bag.¹ Moreover, side seal 246 in BRADY et al, which does run the length of the bag, is through both the patch film and the bag film, directly contrary to Applicants' claimed subject matter recited in amended Claim 18. Applicants contend that there is no teaching or suggestion in COMPTON to have a patch covering two seamless side edges of the same patch bag (COMPTON is not directed to patch bags). Furthermore, there is no teaching or suggestion in COMPTON to seal only through the bag film and not through the patch film (again, COMPTON is not directed to patch bags), and it is clear that Figures 11 and 12 of BRADY et al teach to seal through both the bag film and the patch film. Since neither Figures 11 and 12 of BRADY et al nor COMPTON teach or suggest these features, Claim 18, and Claims 26-30 which depend therefrom, are nonobvious over BRADY et al in view of COMPTON. In summary, Applicants contend that the Office Action fails to establish a prima facie case of obviousness of Claims 18 and 26-30 over BRADY et al in view of COMPTON, because the Office Action fails to account for these differences² between the claimed subject matter with respect to BRADY et al in view of COMPTON.

Turning next to amended independent Claim 20 (as well as Claims 31-35, which depend from Claim 20), Applicants note that Claim 20 recites a pair of side seals and a seamless bottom edge. The patch bag of Figures 11 and 12 of BRADY et al does not have a pair of side seals or a seamless bottom edge (rather, it has only one side seal, and a seamed bottom edge). COMPTON is relied upon for a backseam, which Claim 20 does not recite.

¹ Although Applicants acknowledge that COMPTON does refer to a backseamed *casing*, Applicants note that a casing is a tube, without any transverse seal, such as the bottom seal recited in Claim 18. The Office Action does not refer to any teaching or suggestion in COMPTON which would motivate one of ordinary skill to utilize a backseamed construction for the patch bag illustrated in Figures 11 and 12 of BRADY et al.

² MPEP §706.02 states that the differences between the claims and the prior art should be set forth in the Office Action, as well as the proposed modification necessary to arrive at the claimed subject matter, as well as the reasons why the modifications would have been obvious. Since the Office Action does not address the differences argued above (two seamless side edges instead of one, patch covering both seamless side edges, seal through bag film but not through patch film, etc.), no prima facie case of obviousness has been made out in the Office Action.

Thus, the Office Action fails to set forth a prima facie case of obviousness (for reasons analogous to those argued above relative to the rejection of Claim 18), as the Office Action does not account for the differences between BRADY et al in view of COMPTON, relative to the various features recited in Claim 20, as amended hereinabove.

Nevertheless, Applicants point out that in fact Figure 2 of COMPTON does disclose a side-seal bag having a pair of side seals and a seamless bottom edge. However, there is no teaching or suggestion in COMPTON or BRADY et al to apply a single patch to the bag of Figure 2 of COMPTON so that it covers the seamless bottom edge of the bag and at least a portion of the outer surface of the first and second lay-flat sides of the bag, with the patch having a length of from 101-200 percent of the length of the bag, not to mention applying the patch so that it does not cover the areas where the side seals are located. This combination of features is neither taught nor suggested by BRADY et al in view of COMPTON. Accordingly, Claims 20 and 31-35 are patentable over BRADY et al in view of COMPTON.

In summary, the rejections under 35 USC 103 fail to establish a prima facie case of obviousness. The Office Action relies upon Figures 11 and 12 of BRADY et al, which teaches to seal through both the patch film and the bag film. Moreover, Figures 11 and 12 of BRADY et al are the only figures therein directed to a patch which wraps around an edge of the bag. However, this embodiment teaches to seal through both the patch film and the bag film, directly contrary to amended independent Claims 18 and 20, which recite sealing through the bag film but not through the patch film. All of the remaining patch bag figures in BRADY et al teach using separate patches each of which is confined to a single lay-flat side of the bag, which is also a teaching-away from Applicants' claimed invention. When viewed in this light, it is clear that BRADY et al teaches away from Applicants' invention as recited in each of amended independent Claims 1, 18, and 20.

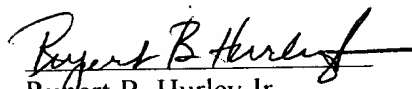
CONCLUSION

Reconsideration of the patentability of the pending claims is respectfully requested, in view of the amendments and arguments set forth above.

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